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10/672,057	09/26/2003	Rami Caspi	2003P08220US	7137

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EXAMINER	
ZEWDU, MELESS NMN	
ART UNIT	**PAPER NUMBER**
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/672,057	CASPI ET AL.	
	Examiner	Art Unit	
	Meless N. Zewdu	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the communication filed on 12/13/07.

2. Claims 1-19 are pending in this action.

3. This action is final.

Claim Objections

Claim 8 is objected to because of the following informalities: the features, "positioning updates --- " and "presence updates ---", stood apart independent of each other. In other words, either the first feature does not cause the second or the second feature does not happen in response to the first. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/672,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because the features claimed in the instant application are recited, if not in a single claim, in various claims in the copending application. For example, the instant claims 1, 4-9, 14 and 16-19 corresponding to copending claims 1, 4, 7-9, 11, 14, 17, 20-22, 24-25; instant claims 2, 10 and 15 correspond to copending claims 2, 10 and 27; instant claims 3, 11-13 correspond to copending claims 17-19, 29 and 30. It is to be noted that "dial-in" telephone recited in copending claims 21 and 22 does not exclude the "toll-free" telephone claims in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/672,364. Although the conflicting claims are not identical, they are not patentably distinct from each other because the key features, "toll-free" telephone (dial-in telephone), "e-mail" message, "correlation" and "rules", recited in the instant claims are recited, if not in a single claim, in various claims in the copending

application (see claims 1, 4, 11, 16, 21, 22, 24). Furthermore, GPS and cellular/wireless network, claimed in the instant claims, are also recited in the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polychronidis et al. (Polychronidis) (US 2003/0018704 A1) in views of Barnett (US 6,958,688 B1) and Yugami (US 2003/0027583 A1)

As per claim 1: Polychronidis discloses a telecommunications system, comprising:

a plurality of network clients including a positioning controller (see fig. 1, element 2; page 1, paragraphs 0021 and 0022), wherein examiner considers the one mobile device of the prior art as an exemplary;

a positioning server including a coordinating controller for maintaining a database of network clients to be tracked (see abstract; fig. 2, element 27 and fig. 4, element 41; page 3, paragraph 0032), said database further including a position-presence correlation information related to party availability for individual users (see

paragraphs 0019-0021). It is to be noted that in providing presence and location information in a manner disclosed by Polychronidis , **correlation** of the two types of information, must be an inherent feature since both types of information are provided together, as indicated by the word "and", to a recipient in response to a request (see claims 1-3).

wherein said positioning server is adapted to receive position information from said plurality of network clients and distribute presence information related to said position information formatted into one or more messages (SMS) to one or more network enterprise devices (see abstract; paragraphs 0022, 0026, 0032). But, Polychronidis does not explicitly teach about receiving position information from said plurality of network client devices via a toll free telephone interface, as claimed by applicant. However, in the same field of endeavor, Barnett teaches about a mobile device initiating a toll-free call for reporting a GPS determined location information to a central hub (see at least col. 4, line 51-col. 5, line 3). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Polychronidis with that of Barnett for the obvious/known advantage of enabling user/s to report location information without incurring a charge or a bill. But, Polychronidis in view of Barnett does not explicitly teach about one or more e-mail formatted messages to one or more network enterprise devices, as claimed by applicant. However, in the same field of endeavor, Yugami teaches about a mobile terminal device (network enterprise devices) that **communicates** location information with a cell system via e-mail. Although the operation of Yugami's terminal appears more

of transmitting location information to the cell site (server) via e-mail, it is also capable of receiving a similar e-mail message from the cell site, as describing in the abstract (see abstract).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references (Polychronidids in view or Barnett) with that of Yugami for the advantage of obtaining position information of a mobile phone device without a user's intervention (see paragraph 0011).

As per claim 2: Polychronidis teaches a telecommunications system, wherein said positioning controller receives global positioning network signals for determining a position of an associated network client (see page 2, paragraphs 0020-0021).

As per claim 3: Polychronidis teaches a telecommunications system, wherein said communications controller comprises a cellular network controller for transmitting on a cellular telephone network to said positioning server (see abstract; figs. 1 and 2; page 1, paragraph 0021).

As per claim 4: some of the features of claim 5 are similar to the features of claim 1 and are rejected on the same ground and motivation as claim 1. Regarding the difference features, Polychronidis teaches about a telecommunications system:

wherein said positioning controller receives global positioning network signals for determining a position of an associated network client (see paragraph 0003);

wherein said communications controller comprises a cellular network controller for transmitting on a cellular telephone network to said positioning server (see figs. 1, 3, 4; paragraphs 0002-0003; 0021).

As per claim 5: the feature of claim 5 are similar to the features of claim 1, except a location control unit adapted to receive and maintain location information for said plurality of users, which is taught by Polychronidis (see fig. 4, elements 46 and 44). Furthermore, since, in Polychronidids, location and presence are provided together (hence correlated), this combined information would have been included in Barnett's e-mail message when the references are modified as shown in the rejection of claim 1 above. Therefore, claim 5 is rejected on the same ground and motivation as claim 1.

As per claim 14: the features of claim 14 are similar to the features of claim 1, except an e-mail controller adapted to receive positioning information control updates from said associated server, which is taught by Yugami (see paragraph 0008). Yugami's reference teaches that a machine/device can communicate via e-mail without human/user's intervention. Hence, claim 14 is rejected on the same ground and motivation as claim 1.

As per claim 15: Polychronidis teaches about a telecommunications device, wherein said positioning controller receives Global Positioning System (GPS) signals to determine said positioning information (see page 1, paragraph 0021).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 1 and 5 above and further in view of Chan (US 6,760,759 B1).

As per claim 6: but, the references applied to the rejection of claim 5 above, do not explicitly teach about, a telecommunication server, wherein said location control unit

receives said location information via an enterprise specific dial-up, as claimed by applicant. However, in a related field of endeavor, Chan teaches about a system to support mobile visual communications wherein a mobile telephone is provided a wireless dial-up capability (see fig. 2, element 21; col. 1, lines 19-22; col. 4, lines 32-36). When the references are combined as shown, a remote device will be able to wirelessly dial-up to a location controller (HLR/MSC) and through the HLR/MSC to NPL Agent. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Chan for the advantage of providing mobile devices with support system for dial-up internet communications.

Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polychronidis, in views of Barnett and Yugami, and further in view of Yoakum et al. (Yoakum) (US 6,658,095 B1).

As per claim 7: the features of claim 7 directed to position-presence correlation, email generation unit and the toll-free telephone interface are similar to the features of claim 1. But, the combination of references applied to claim 1does not explicitly teach about presence correlation **rule**, as claimed by applicant. However, in the same field of endeavor, Yoakum teaches about a customized presence information delivery technique wherein presence rules defined by a user are utilized to deliver presence information (see col. 3, lines 47-61; col. 4, lines 49-56). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify

the above references with the teaching of Yoakum for the advantage of customizing the presence-location information provided by the combination of the above references.

As per claim 8: Polychronidis teaches about a telecommunications method, further comprising:

receiving positioning updates at said remote device (see page 3, paragraph 0036); and updates transmitting presence updates as one or more presence to other local controllers or remote devices as specified in said one or more positioning and

presence correlation (see page 3, paragraph 36; page 4, paragraphs 0051-0063). Furthermore, as shown above (see claims 1 and 7), Barnett provides e-mail as a communication format for exchanging location information. In general, the combination of Polychronidis, Barnett, Yugami and Yoakum (as applied to claim 7), provides presence-location service, toll-free telephone and e-mail format and presence rules. It is known that the HLR, as a mobile user registers to a network, updates its location database or registry. Furthermore, the difference feature in claim 8 is “transmitting, via email, presence correlation rules, to other local controllers or remote devices”, as claimed by applicant and which is taught by Yoakum. Yoakum teaches about a customized presence information wherein presence information is collected and delivered to subscriber based on rules/profiles defined by a user (see col. 2, lines 31-47; col. 4, lines 40-60), including transmitting, via email (see col. 7, line 50-col. 8, line 57), the presence/current information (based on the rules/profile) and dynamic location (location update) (see col. 5, lines 37-62) to subscribing devices. Motivation is same as provided in the rejection of claim 7.

As per claim 9: the feature of claim 9 is similar to the feature of claim 8, except one difference directed to receiving at a server one or more rules set via a network interface device operably coupled to said local controller, which is taught by Yoakum (see fig. 2, particularly, elements 52 and 62; col. 7, lines 10-35).

As per claim 10: Polychronidis teaches a telecommunications method, wherein said receiving positioning updates comprises receiving one or more signals from a global positioning network (see page 2, paragraphs 0020-0021).

As per claim 11: Polychronidis teaches a telecommunications method, further comprising transmitting positioning information from said remote device to one or more servers via a radio-linked network (see figs. 1 and 2; abstract). Polychronidis does not explicitly teach about transmitting position updates, as claimed by applicant. However, Yoakum teaches about dynamically deriving location information from mobile terminals for use of customized presence service (see col. 5, lines 37-62). Motivation is as provided in the rejection of claim 8.

As per claim 12: Polychronidis teaches a telecommunications method, wherein said radio-linked network comprises a cellular telephone network (see abstract; figs. 1 and 2; page 1, paragraph 0021).

As per claim 13: Polychronidis teaches a telecommunications method, wherein said radio-linked network comprises a personal communication service (PCS) network (see page 5, paragraph 0066). PCS is provided by GSM.

As per claim 16: but, the references applied to claims 14 and 15 above, do not explicitly teach about a telecommunications device, further including a rules database of

location and presence related information, as claimed by applicant. However, in a related field endeavor, Yoakum teaches about customized presence information delivery technique wherein presence information to subscribers is delivered based on rules stored in a rules management/database (see fig. 2, element 58; col. 2, lines 31-43; col. 4, lines 35-52). Note: when the references are combined as shown above, the modified reference would have included a rules management/database based on which location and presence information is delivered to subscribers. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Yoakum for the advantage of customizing user defined/customized presence information delivery system for subscribers.

As per claim 19: Yoakum teaches a telecommunications device, wherein said communications controller receives updates to said rules database as e-mails from said associated server (see col. 7, line 59-col. 8, line 13, lines 42-57).

Claims 6, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 14-16 above and further in view of Chan (US 6,760,759 B1).

As per claim 6: but, the references applied to the rejection of claim 5, do not explicitly teach about, a telecommunication server, wherein said location control unit receives said location information via an enterprise specific dial-up, as claimed by applicant. However, in a related field of endeavor, Chan teaches about a system to support mobile visual communications wherein a mobile telephone is provided a wireless dial-up

capability (see fig. 2, element 21; col. 1, lines 19-22; col. 4, lines 32-36). When the references are combined as shown, a remote device will be able to wirelessly dial-up to a location controller (HLR/MSC) and through the HLR/MSC to NPL Agent. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Chan for the advantage of providing mobile devices with support system for dial-up internet communications.

As per claim 17: the references applied to claims 14-16, do not explicitly teach about a telecommunications device, wherein said communications controller transmits changes to location and presence status to said associated server via a wireless dial-up connection, as claimed by applicant. However, in a related field of endeavor, Chan teaches about a system to support mobile visual communications wherein a mobile telephone is provided a wireless dial-up capability (see fig. 2, element 21; col. 1, lines 19-22; col. 4, lines 32-36). Note: Presence-location service, including updating the service is provided in the above references. The clear difference between the above references and the feature of claim 17 is the wireless dial-up feature in claim 17, which is taught by Chan. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Chan for the advantage of providing mobile devices with support system for dial-up internet communications.

As per claim 18: the feature of claim 18 is similar to the feature of claim 17. A modified mobile device would be able to access the NPL service via wireless dial-up.

Response to Arguments

Applicant's arguments filed 12/13/07 have been fully considered but they are not persuasive. Arguments and corresponding responses are appearing below. As an initial matter, examiner felt the use of McDowell's reference (US 2002/0035605 A1) is in redundant with Polychronidis and thus has removed the reference from further considerations. Stated differently, correlating presence-location information is found to be within the scope of Polychronidis' providing presence and location information.

Argument I: with respect to claims 1, applicant argues by saying --- Yugami has nothing to do with transmitting presence via text or email from a server to a client device as generally recited in the claims at issue. Yugami instead relates to transmitting location information from a client device to a server via e-mail and not, as recited, from a presence server to a client device. Applicant further asserts that Polychronidis teaches away from the combination with, e.g., Yugami in other aspects. Polychronidis explicitly states that including location capability --- in a handset can undesirably increase the size complexity, and cost of the handset.

Response I: examiner respectfully disagrees with the argument. In that, seeing the combination of the applied references, Polychronidis provides an NPL system (Network Presence and Location system), wherein presence and location information is provided together a requesting recipient. But, Polychronidis is silent about the use of an e-mail format. This deficiency in Polychronidis is cured by the use of Yugami. While examiner agrees that Yugami is heavily tilted towards transmitting location information

to a hub via e-mail, the reference also teaches that the mobile terminal used in Yugami's reference is capable of t**ransmitting** and **receiving** communications (information) via e-mail (see abstract). Thus, the combination, now, provides, an e-mail communication capable device interfaced with an NPL server. Finally, yes Plychronidis makes a statement of undesirability in including locating modules/components into a handset. But, does not say it is impossible and does not preclude the NPL system therein to interface with Yugami's e-mail capable terminal. Therefore, the argument is held as unconvincing.

Argument II: applicant states that the use of Barnett's reference to relied on for teaching a mobile device initiating a toll-free call for reporting a GPS determined location information to a central hub, is incorrect, as Barnett provides a system in which a user obtains a smart security card associated with an item an item of value and if the item is stolen, the card is swiped at a compatible reader. This information is then, transmitted to a hub, which can identify the location at which the card was scanned.

Response II: examiner respectfully disagrees. Although not in the same page, Column, or paragraph, Barnett teaches that card reader mobile users like pdas or cell phones can send location information to a hub via a toll free number (see col. 4, lines 51-67). Barnet also teaches that mobile users can send GPS determined location information to a hub (see col. 6, lines 29-35). In fact, the scanning of said security card has to do with the description of a stolen item. By a predetermined arrangement, cell phones and pdas are equipped with a reader/scanner and readable cards are to be affixed to items/properties. Under, this arrangement, cell phones and pdas can scan the

card on a stolen item so as to send the information to a proper authority. However, the location is determined using, among other techniques, a GPS system. Therefore, applicant's interpretation of Barnett's reference is incorrect and hence, the argument is found not being convincing.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bost Dwayne D can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature relating to the status of this application of proceeding should be directed to the receptionist whose telephone number is (5710 272-2600.

/Meless N Zewdu/

Primary Examiner, Art Unit 2617/M. N. Z./